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ROBERT E. BUSHNELL
1522 K STREET NW
SUITE 300
WASHINGTON, DC 20005-1202

EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,256

Applicant(s)

OH, KI-HO

Examiner

James W Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

The sentence, "Thus, the resolution of terminal 100 can be automatically adjusted in accordance with data from company 300" on page 14, lines 2-3, is a duplicate of the preceding sentence, lines 1-2 and should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 and 8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (5,732,216) in view of Moskowitz (5,428,606).

Claims 1 and 14-20: Logan discloses a system and method for providing information through the Internet, comprising:

- a. a plurality of user terminal which display visual images to the user (col 1, lines 34-49);
- b. registering the user for a first set of services from a first service provider (col 7, lines 9-12; col 8, lines 63-67; and col 9, lines 28-42);

c. receiving payment from the user for the first set of services (col 27, lines 26-29);

d. receiving by the user a second set of services requested and paid for by the user (col 42, lines 58-61); and

e. receiving payment from the second service provider to the first service provider in accordance with the quantity of services received by the user (col 27, lines 26-29).

While Logan does not explicitly disclose that a manufacturing unit will manufacture and distribute the plurality of terminals, this is the inherent functionality of manufacturing units (factories). Each factory assembles or otherwise makes the products (e.g. Logan's terminals) which are then distributed through the factory's distribution channels. Furthermore, it is old and well known for manufacturers to distribute products directly to end users, such as the cellular telephone service provider Sprint™ selling its own cellular telephones (and subscription services) at kiosks in malls. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture and distribute Logan's terminals to users. One would have been motivated to not only manufacture the terminals, but also distribute the terminals to users in order to provide the hardware needed to perform Logan's invention.

While Logan discloses the user separately paying for the first and second set of services and the second service provider paying the first service provider (a service fee) when the user accesses one of the second services, it is not explicitly disclosed that the

amount of the payments will increase when the quantity of terminals distributed increases or when the number of subscribers increases. However, the amount charged and paid by the entities involved in commercial transactions may be calculated in innumerable ways and may be based on any criteria, payment schedule, etc. agreed upon by the entities involved. While it is usual for a service provider to initially charge a lower fee than competitors in order to entice customers to subscribe to their new service, it is also common when the service provider has reached or is nearing its system's "saturation point" to raise the fees, since there is no longer a need to attract a large quantity of new subscribers (at least until the system can be expanded). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to increase the amount charged when the number of terminals distributed or the number of subscribers increases. One would have been motivated to increase the amount in order to maximize revenue.

While Logan discloses that the second service provider pays the first service provider, it is not explicitly disclosed that the first service provider is the manufacturer of the terminals. However, it is obvious that the manufacturer and the first service provider could be the same entity, as in the example above where Sprint™ is manufacturing, distributing, and providing subscription service for its cellular telephones. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the payment from the second service provider could be made to the manufacturer of the terminals. One would have been motivated to pay the

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manufacturer when the manufacturer is also the entity which provides the first set of services.

Claim 2: Logan discloses a system for providing information over the Internet as in Claim 1 above, and further discloses the user data including at least one of a user name, user address, date of birth, gender, age, etc. (col 9, lines 28-42 and col 23, line 62 – col 24, line 5).

Claims 3-5: Logan discloses a system for providing information over the Internet as in Claim 2 above, and further discloses the user data including at least one category of interest to the user, such as weather or news and the first and second services corresponding to at least one of politics, economics, society, culture, sports, games, computers, Internet banking, securities, stock trading, insurance, travel, or any other category or service in which the user may be interested (col 9, lines 28-42; col 29, lines 36-47; col 35, lines 66-67; and col 38, lines 16-19). The Examiner notes that the areas of interest and the types of services offered by the first and second service providers do not affect the steps of the claimed system and are given little if any patentable weight. It is obvious that each user would have his own unique set of interests and desired set of services and that the system would be modified to present the information and services which match the user's data as discussed by Logan.

Claims 8-13: Logan discloses a system for providing information over the Internet as in Claim 1 above, and further discloses registering the user and providing the user data from the vendor to the central system (for targeting the information and the advertisements). However, it is not explicitly disclosed that the registration will take place when the user receives the terminal (Claim 8), when the user buys the terminal (Claim 9), or when the user initially connects to the first server provider (Claim 13). It would have been obvious to one having ordinary skill in the art at the time the invention was made that the user could provide the registration data (Logan's account initialization) at any time prior to using the system, as long as the data was available for targeting purposes when the user accesses the system. One would have been motivated to obtain the user's registration data in one or more of these ways in order to facilitate the registering of users who obtain the terminal through various channels, such as via postal mail, in person as a gift from a friend, in a store, etc.

4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (5,732,216) in view of Moskowitz (5,428,606).

Claims 6 and 7: Logan discloses a system for providing information over the Internet as in Claim 1 above, and further discloses the terminal unit is "a player/recorder unit capable of reproducing received audio recordings for a listener, and further capable of recording comments, annotations, messages, and responses to information requests imbedded in received messages" (col 1, lines 42-49) which is connected to the central system "via dial up telephone facilities" or "cellular radio, cable

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modem and satellite links" which may be used to "facilitate use of the system in an automobile" (col 6, lines 39-48). While Logan does not explicitly disclose that the terminal is one of a web phone, web television, personal data assistant, or cellular telephone, Moskowitz discloses a similar system for providing information over the Internet in which the terminal (modular expandable unit) uses "private circuits, television lines, the public switched telephone network, cellular communications, electric power lines, or even satellite communications" (col 5, lines 64-68) and describes the terminal as including "a central processing unit"..." a small video screen 22, an apparatus for inputting commands 26 (e.g. a keyboard or a pointing device), and software for user interaction" (col 6, lines 61-65). The claimed list of electronic communication devices all contain at least these features and would have been obvious choices as the terminal in Logan. One would have been motivated to choose one of these mobile communication devices in order to allow more freedom of movement by Logan's user, thus expanding the system beyond the user's car.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Nadan (5,321,750) discloses a system and method for providing information, such as market data, to subscribers.

b. Herz et al (5,754,938) discloses a system and method for providing customized information to subscribers over the Internet.

- c. Goldhaber et al (5,855,008) discloses a system and method for providing information to subscribers over a computer network, such as the Internet.
- d. Brown et al (5,887,133) discloses a system and method for providing customized information (documents) to subscribers over the Internet.
- e. Stewart et al (6,259,405) discloses a system and method for providing information and services to a portable computing device of a subscriber based on the subscriber's personal data.
- f. Herz (6,460,036) discloses a system and method for providing customized newspapers to subscribers over the Internet.
- g. Lohtia et al (6,560,456) discloses a system and method for providing subscriber-initiated information over the Internet.
- h. Rajan et al(6,725,425) discloses a system and method for providing information to subscribers from semi-structured web-based data sources.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be submitted directly to the examiner at (703) 746-5544.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM
June 16, 2004



James W. Myhre
Primary Examiner
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